

### REMARKS/ARGUMENTS

By this paper, Applicant requests under MPEP § 710.06 that the Action of March 14, 2012 be vacated, and a new Action issued that complies with all regulations and guidance governing examination. Applicant maintains that the Office Action was not properly made final and finality should be withdrawn. Applicant submits that no rejections are proper and that the case is in condition for allowance. This paper supplements the arguments previously filed June 14, 2012 and September 14, 2012 by pointing out new language in the revised MPEP at §2111.05 III relevant to the issues presented.

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**I. The Rejection Under §103 Relies Upon a Fabricated Rule of Law Relating to “Descriptive Material” That is Not Law and Is Contrary to MPEP §2111.05**

Claims 28-30, 53-55, and 181-203 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weatherly et al., U.S. Patent No. 6,049,784.

Weatherly fails to meet Applicant’s claims. In Action after Action, Examiners Subramanian and Kyle refuse to give claim language patentable weight in the analysis under 35 U.S.C. § 103 by relying on a so-called “descriptive material” exclusion for claim language. Claim language that distinguishes the claims from the prior art is ignored and not given patentable weight on the grounds that it is descriptive. Then, the Examiners reject the claims by rejecting the redacted claim language based upon the prior art. Examiners Subramanian and Kyle use no form paragraph. Rather, these Actions rely on examiner-improvised legal analysis.

In Reply after Reply, this Applicant has argued against these rejections as improper and not based upon law. All prior art rejections in this case are based upon first disregarding claim language. The cited prior art does not show or render obvious what is claimed.

With respect to the rejection of Claims 28-30, 53-55 and 181-203 under 35 U.S.C. 103(a) as unpatentable over Weatherly et al., the rejections acknowledge that the Weatherly patent does not disclose numerous features recited in the claims. The Office Action then states, "However these features are interpreted as *non-functional descriptive material* as they do not materially affect the steps of soliciting proposals, soliciting offers of financing and notifying the respective parties when an offer matches a proposal." May 26, 2011 Action at page 15. A similar statement appears at page 17, lines 7-10 of the March 14, 2012 Office Action (emphasis added). Thus, the Examiner gives no patentable weight to much of the recited claim language.

The Eighth Edition, Revision 9 of the MPEP which came out in August 2012 and which is now available online deals with Functional and Nonfunctional Descriptive Material in the new Section 2111.05. A copy of the complete section is attached. Section 2111.05 III deals with Machine-Readable Media and the rejections under 35 U.S.C. §103 in this case are contrary to MPEP §2111.05 III. This section states:

**2111.05 Functional and Nonfunctional Descriptive Material  
[R-9]**

**III. Machine-Readable Media**

When determining the scope of a claim directed to a computer-readable medium containing certain programming, the examiner should first look to the relationship between the programming and the intended computer system. Where the programming performs some function with respect to the computer with which it is associated, a functional relationship will be found. For instance, a claim to computer-readable medium programmed with attribute data objects that perform the function of facilitating retrieval, addition, and removal of information in the intended computer system, establishes a functional relationship such that the claimed attribute data objects are given patentable weight. See *Lowry*, 32 F.3d at 1583-84.

However, where the claim as a whole is directed conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists. For example, a claim to a memory stick containing tables of batting averages, or tracks of recorded music, utilizes the intended computer system merely as a support for the

information. Such claims are directed toward conveying meaning to the human reader rather than towards establishing a functional relationship between recorded data and the computer.

In the claims in this case, the computer-readable medium is programmed and the programming performs functions with respect to computers with which it is associated. Hence there is a functional relationship. The present case does not involve a computer-readable medium which merely serves as a support for information or data. The present claims are not directed to conveying meaning to a human reader like a memory stick or tracks of recorded music. Thus, MPEP §2111.05 III makes it clear that the rejection under 35 U.S.C. §103 relying upon descriptive material are improper. The claims are patentable in view of the prior art of record.

The rejections of claims 28-30, 53-55 and 181-203 under 35 U.S.C. 103(a) as unpatentable over Weatherly et al. (U.S. Patent No. 6,049,784) are improper and should be withdrawn. It is respectfully submitted that the claims are not met by Weatherly et al., whether taken alone or in combination with the prior art of record or other unspecified teachings.

## **II. Conclusion**

Applicant respectfully submits that the claims are supported by the specification as filed; in compliance with 35 U.S.C. §112, second paragraph; statutory subject matter under 35 U.S.C. §101; and patentable under 35 U.S.C. §103 in view of Weatherly taken alone or in combination with other prior art of record or other unspecified teachings.

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to

telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. For the entire pendency of this application, the Commissioner is hereby authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3219, Order No. 1906-3-Polestar.

Respectfully submitted,

For

TI FUNDING GROUP, L.L.C.

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## **2111.05 Functional and Nonfunctional Descriptive Material [R-9]**

USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Since a claim must be read as a whole, USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004). The rationale behind the printed matter cases, in which, for example, written instructions are added to a known product, has been extended to method claims in which an instructional limitation is added to a method known in the art. Similar to the inquiry for products with printed matter thereon, in such method cases the relevant inquiry is whether a new and unobvious functional relationship with the known method exists. See *In re Kao*, 639 F.3d 1057, \_\_\_, 98 USPQ2d 1799, 1811-12 (Fed. Cir. 2011); *King Pharmaceuticals Inc. v. Eon Labs Inc.*, 616 F.3d 1267, \_\_\_, 95 USPQ2d 1833, 1842 (Fed. Cir. 2010).

### **I. Determining Whether a Functional Relationship Exists**

#### **A. Evidence For a Functional Relationship**

To be given patentable weight, the printed matter and associated product must be in a functional relationship. A functional relationship can be found where the printed matter performs some function with respect to the product to which it is associated. See *Lowry*, 32 F.3d at 1584 (citing *Gulack*, 703 F.2d at 1386). For instance, indicia on a measuring cup perform the function of indicating volume within that measuring cup. See *In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (CCPA 1969). A functional relationship can also be found where the product performs some function with respect to the printed matter to which it is associated. For instance, where a hatband places a string of numbers in a certain physical relationship to each other such that a claimed algorithm is satisfied due to the physical structure of the hatband, the hatband performs a function with respect to the string of numbers. See *Gulack*, 703 F.2d at 1386-87.

#### **B. Evidence Against a Functional Relationship**

However, where a product merely serves as a support for printed matter, no functional relationship exists. Such a situation would occur for a hatband with images displayed on the hatband but not arranged in any particular sequence. See *Gulack*, 703 F.2d at 1386.

Another example in which a product merely serves as a support would occur for a deck of playing cards having images on each card. See *In re Bryan*, 2009 U.S. App. LEXIS 6667 (Fed. Cir. 2009) (unpublished). See also *Ex parte Gwinn*, 112 USPQ 439, 446-47 (Bd. App. 1955), in which the invention was directed to a set of dice by means of which a game may be played. The claims differed from the prior art solely by the printed matter in the dice. The claims were properly rejected on prior art because there was no new feature of physical structure and no new relation of printed matter to physical structure. These situations may arise where the claim as a whole is directed towards conveying a message or meaning to a human reader independent of the supporting product. For example, a claimed measuring tape having electrical wiring information thereon, or a generically claimed substrate having a picture of a golf ball thereupon, would lack a functional relationship as the claims as a whole are directed towards conveying wiring information (unrelated to the measuring tape) or an aesthetically pleasing image (unrelated to the substrate) to the reader. Additionally, where the printed matter and product do not depend upon each other, no functional relationship exists. For example, in a kit containing a set of chemicals and a printed set of instructions for using the chemicals, the instructions are not related to that particular set of chemicals. *In re Ngai*, 367 F.3d at 1339.

## **II. Functional Relationship Must be New and Unobvious**

Once a functional relationship between the product and associated printed matter is found, the investigation shifts to the determination of whether the relationship is new and unobvious. For example, a claim to a color-coded indicia on a container in which the color indicates the expiration date of the container may give rise to a functional relationship. The claim may, however, be anticipated by prior art that reads on the claimed invention, or by a combination of prior art that teaches the claimed invention.

## **III. Machine-Readable Media**

When determining the scope of a claim directed to a computer-readable medium containing certain programming, the examiner should first look to the relationship between the programming and the intended computer system. Where the programming performs some function with respect to the computer with which it is associated, a functional relationship will be found. For instance, a claim to computer-readable medium programmed with attribute data objects that perform the function of facilitating retrieval, addition, and removal of information in the intended computer system, establishes a functional relationship such that the claimed attribute data objects are given patentable weight. See *Lowry*, 32 F.3d at 1583-84.

However, where the claim as a whole is directed conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists. For example, a claim to a memory stick containing tables of batting

averages, or tracks of recorded music, utilizes the intended computer system merely as a support for the information. Such claims are directed toward conveying meaning to the human reader rather than towards establishing a functional relationship between recorded data and the computer.